

Attorney Docket No. 5621 P1
Customer No. 49459

REMARKS

35 U.S.C. § 103(a) Rejections

Claims 1 and 2 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Murray et al., U.S. Patent No. 5,986,030, in view of Noguchi et al., JP 49043688. More specifically, the Examiner states the following: "Murray teaches the process and use of the quaternary group, and Noguchi et al teaches similar compound having the fluorescent properties, one of skill in the art would be motivated to use the compound Noguchi with quaternary substituent for the process of Murray, especially as Murray teaches a variety of groups with one quaternary substituent. The motivation exists in the fact that the compounds have the same substituent and same property as those used by Murray and hence it would be obvious to make the modification on the compounds to obtain the compounds of the invention."

Applicants respectfully traverse the Examiner's rejection.

Murray teaches a composition that has a quaternary ammonium group with an attached fluorophore.

Noguchi teaches a composition that contains two benzene rings, both of which have a substituent containing a quaternary ammonium group.

The present invention teaches a composition containing a naphthalimide containing fluorescent moiety. More specifically, there are two benzene groups in the naphthalimide and only one of them has a quaternary ammonium group.

A prima facie case for obviousness requires that there be motivation in the prior art to make the claimed the invention. In this case, claim 1 is directed to a specific set of fluorescent monomers. None of the cited prior art teaches the claimed fluorescent monomer. More specifically, Noguchi and claim 1 are completely different chemistries and Murray and claim 1 are completely different chemistries. There is no motivation in the prior art to combine a fluorophore group of one chemistry and apply it to another different chemistry, or in essence to pick and choose parts of one chemistry and meld it with a different chemistry. The Examiner fails to show what motivation in the art would lead one of ordinary skill in the art to make the claimed invention. More specifically, one of ordinary skill in the art would not be motivated to select/pick and choose two different fluorescent-based molecules out of hundreds or more of different fluorescent molecules, and mix and match parts of

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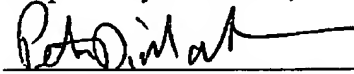
those two molecules to make the claimed invention. The only potential motivation to do this would come the application itself and that is hindsight reconstruction, which is impermissible as a source of motivation to make the claimed invention. Applicants therefore request the removal of this rejection and the allowance of claim 1 and claim 2, which depends upon an allowable base claim.

Attorney Docket No. 5621 P1
Customer No. 49459

CONCLUSION

Applicants respectfully request that a Notice of Allowance be sent for all pending claims.

Respectfully Submitted,



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